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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
Eckard et al.
Serial No. 09/773,054
Filed: 01/31/2001
For: SPECIAL SERVICE STATION
MODULE FOR EXTRA SERVICING

} Art Unit: 2863
Examiner: Nghiem, M.

REPLY BRIEF

Commissioner for Patents
Alexandria, VA

Sir:

This reply brief is in response to the Examiner's Answer mailed February 8, 2005 (the "Answer").

Grouping of Claims

The Answer asserts that the rejection of Claims 9, 21 and 34-44, and the rejection of Claims 12 and 25 stand or fall together, on the grounds that the brief did not include a statement under 37 CFR 1.192(c)(7). However, Section 1.192(c)(7) was among sections withdrawn and reserved as of September 13, 2004. Appellants contend that these claims should be separately considered, for the reasons stated in the appeal brief.

The Rejection under Section 102(e)

1. The Answer inconsistently interprets the Garcia reference.

The rejection under Section 102(e) is based on an interpretation of Garcia, under which the "second service module" is interpreted by the Examiner to read on either a wiper element (232) or a capper (234) which are part of the unit 230, i.e., to use the terminology used in Garcia, the service module 230.

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Yet, in discussing the rejection, the answer inconsistently relies on descriptions of the module 230 when referring to the "second service module". For example, at page 5, first complete paragraph, of the Answer, the Examiner states that, regarding Claim 37, Garcia et al. discloses removing the first service module from the printer (by removing service module, column 8, lines 65-67), installing the second service module in the printer (by replacing with new service module, column 8, line 67), and using the set of instructions and the second service module, conducting a special servicing operation (column 8, lines 63-64). This passage of Garcia refers not to the "second service module" as interpreted by the Examiner, but rather to the service module 230, i.e. the service module as the term is used in Garcia, not in the sense the Examiner has used in the rejection. Appellants submit that the Primary Examiner cannot have it both ways.

2. The "Removably Installable" Limitations

The Examiner's position, stated at page 7 of the Answer, that "the second service module **removably installable** on the printer" merely states a capability of the second service module, is a newly asserted position. This is apparently with respect to Claims 9, 12, 21, 25, 34 and 40 which include this passage. It is not seen how the new position supports the rejection. Moreover, the recitation, "the second service module **removably installable** on the printer," is a limitation which must be given patentable weight.

3. Examiner's Interpretation of Exploded View FIG. 23 To Support Assembly/Removal Interpretation

The Answer states, at page 7, that Fig. 23 of Garcia "clearly shows that the wiper (234) and the capper (236) are two separate parts being assembled into a top plate (380). Thus, any person skilled in the art would conclude that inasmuch as the wiper (234) and the capper (236) are capable of being installed onto the top plate (380), they are also capable of being removed from the top plate (380) (reverse of the installation steps)." Applicants respectfully deny that Garcia provides this description. FIGS. 14A-14-B are respective isometric and side views of a service station module;

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Garcia at 2:63-65. FIG. 23 is an exploded isometric view of the service station module; Garcia at 3:19-20. These figures do not depict assembly of parts, but rather FIG. 23, as just noted, is an exploded view of the service station module. Nor can it be fairly said that one of ordinary skill would conclude that the wiper (234) and capper (236) are capable of being removed from the top plate (380).

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. MPEP 2112(IV).

Here, the Examiner has not established that the service module of Garcia meets the claim limitations. For example, there is no reason to assume that the top plate (380) would be removable from the housing (230) after fabrication; the top plate could very well be permanently welded in place or secured by an adhesive. This would prevent the wiper (234) from being disassembled from the service module (230) by the printer user. Further, while the Examiner argues that FIGS. 14A-14B show a fastener, there is no reason to assume that this is a fastener, let alone a removable fastener which would allow removal of the capper (236). Rivets could be used, which are not removable without destruction. Adhesives could also be used to secure the capper in position on the top plate. It is not enough to argue that a removable fastener might be used, rather, the MPEP 2112(IV) and the authorities cited therein establish that Garcia would have to require this result.

A similar argument applies to the position stated at page 8 of the Answer that "even though Garcia describes that the service station can be removed and replaced at the same time that the associated printhead is removed, nothing is found in the Garcia description that would prevent the wiper (234) or the capper (236) from the capability of being "removably installable" on the printer with respect to the other service module. The Examiner seeks to read into the reference teachings which do not exist. Moreover, it is not enough to allege that nothing is found that would prevent

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the wiper or capper from capability of being removable installable on the printer; this does not satisfy the requirements of MPEP 2112 and the authorities cited therein.

4. Interpreting the Garcia Patent Document as Reading on Claim Limitations "Providing a Set of Instructions for Using the Second Service Module with the Inkjet Printer to the Printer User"

The Answer asserts that the patent document of Garcia *per se* is the human-readable instructions for using the second service module (234, 236). Appellants disagree that Garcia meets the claim limitations as the human-readable instructions, for reasons given in the Appeal Brief. Moreover, the Answer does not provide any showing that the alleged instructions are provided to the printer user, i.e. that the Garcia document is provided to the printer user. The fact that a patent is publicly available does not meet the claim limitations, e.g. of Claim 9 and 21 (providing a set of instructions for using the second service module with the inkjet printer to the printer user, wherein the step of providing a set of instructions includes providing a set of human-readable instructions for using the second service module). The assumption that a document exists which includes the recited instructions does not meet the limitation that it is provided to the printer user. How is the printer user to find the alleged instructions? She would be required to perform a search of over six million patent documents to find one document? How would the printer user know where to search?

Appellants submit that the Office's interpretation, even assuming a broad reading of the claim, fails to fairly read on the claim limitations. For example, one would have to find that Garcia includes the set of instructions as defined in the rejected claims, e.g. Claims 9 and 21, and that Garcia describes that a copy of the patent document would be provided to the printer user. The reference does not include this description, and so a *prima facie* case of anticipation has not been established.

5. Examiner's Position that Garcia Describes a New Service Module Different from the First Service Module.

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At pages 10-11 of the Answer, the Examiner addresses Appellants' argument regarding Claim 37 that Garcia does not describe that the second service module is different from the first service module and intended to address a printhead-related service condition not adequately addressed by the first service module in an un-worn condition. The Examiner's position is that the new service module (236) is different from the first service module (234), and adapted to address a printhead-related service condition (wherein printhead needs suctioning by capper 236) not adequately addressed by the first service module (wiper 234 cannot perform suctioning) being in the unworn condition (wiper 234 is in an un-worn condition). The position does not meet the claim limitations of Claim 37:

removing the first service module from the printer;
installing the second service module in the printer;
using the set of instructions and the second service module,
conducting a special servicing operation.

The Examiner's position does not address, for example, removing the first service module (wiper 234) from the printer and installing the second service module (capper 236) in the printer. Why would one applying Garcia's service module remove a wiper and install a capper to perform capping, when the module 230 already includes both elements?

6. The Examiner's Position that Claims are Given Their Broadest Reasonable Interpretation During Prosecution.

Appellants do not disagree that claims are given a broad reasonable interpretation during prosecution, but even so, the interpretation must be reasonable. As appellants have pointed out, the interpretation of Garcia by the Examiner does not meet the claim limitations. Moreover, if the claims, given this broad reasonable interpretation are not anticipated by a reference, then applicants need not amend the claims to meet an anticipation rejection based on that reference.

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The Section 103 Rejection

Appellants stand on their position in the Appeal Brief regarding the obviousness rejection.

CONCLUSION

The rejections under 35 USC 102 and 103 must be reversed. Prima facie cases of anticipation and obviousness have not been made, and the cited references do not teach or suggest the claimed invention.

Respectfully submitted,



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